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**REMARKS**

Claims 1-24 are pending in the present application. In the Office Action mailed December 5, 2003, the Examiner rejected claims 1-24 under 35 U.S.C. §103(a) as being unpatentable over Canfield, II et al. (USP 5,897,498) in view of Eastvold et al. (USP 6,487,513). Additionally, claims 1-24 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-44 of Application No. 09/199,506.

**Background**

Canfield, II et al. was first made of record in the Office Action of February 3, 2003. However, the reference was not applied to the claimed invention until after Applicant overcame all previous rejections – which were obviousness-type rejections under §103(a). The Examiner then rejected each and every claim as anticipated by Canfield, II et al. – a previously known reference in an Office Action dated June 25, 2003. However, “[i]n rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command.” 37 CFR 1.104(c). Therefore, Applicant expressed confusion as to how the Examiner can later present a rejection under §102(e) when the reference previously considered by the Examiner to be the “best” reference was presented as a rejection under §103(a). Applicant requested clarification. However, the Examiner has not provided any explanation.

In the current Office Action mailed December 5, 2003, the Examiner acknowledged that the previous rejection under §102(e) based on Canfield, II et al. was unsustainable. As such, the Examiner rejected claims 1-24 as being unpatentable over Canfield, II et al. in view of Eastvold et al. It is noted that this application has been pending since December 29, 1999, and Applicant has not filed any RCE, CPA, or continuation of any kind. While Applicant appreciates the Examiner’s efforts to provide a thorough examination, Applicant believes the prosecution of this case is being unnecessarily prolonged.

Therefore, while Applicant acknowledges the Examiner’s duty to perform a thorough search and examination as outlined in MPEP §904.01, and appreciates the same, Applicant reminds the Examiner that it is also the Examiner’s duty to avoid delay in prosecution and unreasonably forestall a resolution of pending applications generally. See MPEP §904.03. Applying a reference that was previously considered insufficient to substantiate any rejection, then applying it as a §102 rejection, then applying it as a §103 rejection, appears to add nothing but unnecessary burden and cost to prosecution, for both the Applicant and the Office.

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**Rejection Under §103(a)**

To substantiate the current rejection, the Examiner has ignored explicit elements of the claims and misinterpreted the reference. The Examiner has ignored the fundamental differences in function and purpose between the claimed invention and that which is disclosed by Canfield, II et al. and Eastvold et al. For example, Canfield, II et al. teaches an "ultrasound diagnostic imaging system with electronic message communications capability." *Title of Canfield, II et al.* On the other hand, as was fully addressed in detail in the Response of August 22, 2003, the independent claims specifically call for "an in-field product...that is not readily capable of direct communications." *Claim 1*. Therefore, while the very focus and purpose of Canfield, II et al. is a system where the in-field product, i.e. an ultrasound system, is capable of direct communications, the claimed invention is directed to the exact opposite. That is, the claimed invention is directed to a system to allow remote communications, servicing and the like, when the in-field product is not readily capable of direct communications.

Nevertheless, the Examiner entirely ignored this fact and failed to respond to Applicant's arguments. Instead, the Examiner stated that "Canfield discloses...an in-field product at a customer site that is not readily capable of direct communication with the on-line center." (Emphasis added.) The Examiner's statement is not only incorrect, it is blatantly wrong as illustrated in the Response dated August 22, 2003.

Specifically, the Examiner asserted that column 2, lines 52-63 teaches "an in-field product...that is not readily capable of direct communication with the on-line center" and "at least one portable service interface operable with the in-field product." However, as clearly pointed out in the Response of August 22, 2003, the citation merely provides a general operational background of an ultrasound system and fails to address any element of the claim other than an "in-field product," i.e. ultrasound system. Continuing into column 3, which the Examiner did not cite, Canfield, II et al. teaches that "[t]he ultrasound system 10 includes a HyperText Transfer Protocol (HTTP) server 30." Col. 3, ll. 19-20, emphasis added. The integrated HTTP server allows the ultrasound system to directly communicate reports to a "personal computer, terminal, or workstation at a remote location." Col. 3, ll. 23-24. Therefore, Canfield, II et al. specifically teaches directly away from an in-field product that is **NOT** readily capable of direct communication with the on-line center and a portable service interface operable with the in-field product by teaching that the ultrasound system have integrated means for internet communications.

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The Examiner acknowledged that "Canfield does not explicitly disclose at least one on-line center having access to service software at a centralized facility so as to service in-field product remotely." However, the Examiner asserted that Eastvold et al. discloses such.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. MPEP §2142. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes each and every element of the claimed invention, but also provide "a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex Parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). That is, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP §2143.01. "The fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness." *Id.* When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Applicant believes that a *prima facie* case of obviousness has not been established and one cannot be made based on the art of record. In combining these references, the Examiner is ignoring explicit shortcomings of the references, in the rejection, and the non-trivial distinctions clearly set forth in the Response mailed August 22, 2003.

As stated, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

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ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

## MPEP §2143

Applicant believes that a *prima facie* case of obviousness cannot be made based on the art of record because, as will be detailed below, (1) the references are directed to very different purposes and there is no motivation to combine these references in a way done so by the Examiner, other than using Applicant's own teaching; (2) such a combination would not have a reasonable expectation of success; and (3) all the elements of the present claims are not present in the references. The Examiner has not established any one of the three basic criteria required under MPEP §2143. Applicant will now address each of these three criteria required by MPEP §2143.

First, Canfield, II et al. is direct to an "ultrasonic diagnostic imaging system with electronic message communications capability." *Title of Canfield, II et al.* (emphasis added). On the other hand, Eastvold et al. is directed to a "diagnostic test unit network and system." *Title of Eastvold et al.* (emphasis added). One of ordinary skill in the art would not be motivated to combine an electronic message communications system with a diagnostic test unit network in the hopes of yielding the claimed invention, i.e. a "system and method for remote servicing of in-field product...that is not readily capable of direct communication..." Simply, when seeking a system and method for remote servicing of in-field product, Canfield, II et al. and Eastvold et al. are nonanalogous art. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992).

Second, even if Canfield, II et al. and Eastvold et al. were to be combined, the combination would not successfully yield the claimed invention. The systems taught by Canfield, II et al. and Eastvold et al. both include an in-field product that IS readily capable of communications, whereas the claimed invention explicitly includes an in-field product that is NOT readily capable of direct communications. Therefore, the present invention solves a problem that is wholly inapplicable to the references. In fact, Canfield, II et al. is clear that the in-field products are readily capable direct communications. Col. 3, lns. 19-20 and Col. 3, lns. 23-24. Therefore, any combination of Canfield, II et al. and Eastvold et al., in an attempt to produce the claimed invention, would not have a reasonable expectation of success – with respect to the claimed invention. The Examiner cannot disregard claim limitations.

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Third, as explained above, all the elements of the present claims are not present in the references. Specifically, the systems taught by Canfield, II et al. and Eastvold et al. both include an in-field product that IS readily capable of communications while the claimed invention explicitly includes an in-field product that is NOT readily capable of direct communications.

Accordingly, the Examiner cannot sustain the present rejection because (1) the references are directed to very different purposes and there is no motivation to combine these references in a way done so by the Examiner; (2) the combination would not have a reasonable expectation of success; and (3) all the elements of the present claims are not present in the cited references. Not only has the Examiner not established all three of these required basic criteria under MPEP §2143, the Examiner has not even established one of them, and, therefore, the current rejection is not sustainable.

For all these reasons, Applicant believes claim 1 is patentably distinct from the cited art. Claims 2-9 are also in condition for allowance pursuant at least to the chain of dependency. Applicant highlighted some of the numerous elements that were not addressed by the Examiner and further distinguished the claimed invention from the cited art in the Response of August 22, 2003, and incorporates that response herein. The Examiner failed to respond to Applicant's remarks and merely asserted that the claims are obvious in light of the combination of Canfield, II et al. and Eastvold et al. The Examiner made no effort to address Applicant's arguments with respect to the new basis of rejection and merely restated the rejections of claims 2-9 provided in the Office Action mailed June 25, 2003, which did not include Eastvold et al. Therefore, Applicant reiterates the remarks made in the Response mailed August 22, 2003. As such, should the Examiner find Applicant's remarks unpersuasive, Applicant requests reasoned statements illuminating the Examiner's position for purposes of appeal.

Regarding claim 3, the Examiner cited column 8, lines 5-37 as teaching the claimed invention. First, as previously shown, Canfield, II et al. does not teach service software. Therefore, Canfield, II et al. does not teach that the service software be designed for utilization with "a wide variety of medical image scanner." Second, Canfield, II et al. does not teach "a wide variety of medical image scanners" but a system for use with only ultrasound type medical image scanners. The Examiner is reminded that to sustain a rejection under §102, the reference must teach each and every element of the claim. MPEP §2131. Third, claim 3 is specific that the on-line center "automatically downloads the selected service software." Canfield, II et al. teaches away from automated downloads by stating that an operator may use a browser to access system

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preset data or that "the operator may download the custom preset data directly to scan parameter storage." Col. 7, ll. 30-36. Simply, Canfield, II et al. teaches that any downloading requires an operator to effectuate the download. Therefore, Canfield, II et al. teaches away from automated downloads. For all of the above reasons, claim 3 is patentably distinct from the art of record.

Regarding claim 5, the Examiner cited column 8, lines 15-27 as teaching that data accessed from the on-line center includes at least one of a configuration file, a golden file, a protocol, and a software program. However, the citation merely teaches electronic messaging to transmit a system error log, status, and configuration, and to automatically send the error log to the manufacturer or to a repairman. This is not a description of the present invention. The cited section does not teach accessing data from the on-line center, but merely sends data to an on-line center. The Examiner is again reminded that to reject a claim, the reference(s) must teach each and every element of the claim, not something that is "sort of close." See MPEP §2131. As such, claim 5 is patentably distinct over the cited art.

Regarding claim 8, the Examiner stated that column 3, lines 20-67 teach that "the portable service interface is a laptop computer having loaded therein remote resource communications software to automatically communicate with the on-line center and transfer data therebetween." However, the sentence preceding the Examiner's lengthy citation teaches that "the ultrasound system 10 includes a HyperText Transfer (HTTP) server 30." Col. 3, ll. 19-20. Canfield, II et al. then teaches that "[t]he server 30 is connected to the modem 32." Therefore, the ultrasound system is as an integrated server for communications with the on-line center and data transfer therebetween and does not teach a laptop computer. Claim 8 is also patentably distinct over the cited art.

Regarding claim 10, the Examiner rejected the claim by citing "see rejection of claim 1, supra." Accordingly, Applicant incorporates herein the relevant remarks with respect to claim 1 and those arguments previously set forth in the last response. However, claim 10 is "independent" and different from claim 1, and requires "independent" analysis. Applicant hereby requests such examination to complete the record.

The only element of claim 10 specifically addressed by the Examiner is "accessing data from the in-field product with the portable service interface." To reject this element, the Examiner cites column 8, lines 15-27, which teaches that "[t]he electronic messaging system can be configured to automatically capture system information when a problem occurs, such as the system error log, status and configuration, and to automatically send the error log to the

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manufacturer or repairman at the time of the problem.” Nowhere does it teach or suggest “accessing data from the in-field product with the portable service interface.” As previously shown, Canfield, II et al. does not teach or even suggest a portable service interface and, therefore, does not teach or suggest that the portable service interface accesses data from the in-field product. The Examiner seems to be repeatedly ignoring explicit claim limitations -- in this case, “a portable service interface.” Instead, the Examiner is citing sections that teach sending or receiving information while ignoring the specifics of the communication.

Additionally, the Examiner has failed to meet the burden required to establish a *prima facie* case of obviousness under MPEP §2143. Specifically, as stated above with respect to claim 1, the Examiner cannot sustain the present rejection because (1) the references are directed to very different purposes and there is no motivation to combine these references in a way done so by the Examiner; (2) the combination would not have a reasonable expectation of success; and (3) all the elements of the present claims are not present in the references. The Examiner has not established any of the three required criteria under MPEP §2143 and, therefore, the current rejection is not sustainable. As such, Applicant believes claim 10 is patentably distinct over the cited art. Furthermore, claims 11-20 are in condition for allowance at least pursuant to the chain of dependency.

Regarding claim 21, the Examiner rejected the very first elements of the claim by citing column 2, lines 52-63. Specifically, the Examiner asserted that the citation teaches “[a] method of servicing an in-field product not readily capable of direct communication with a remote on-line center comprising: providing a portable service interface having software for communication with an on-line center.” However, the cited section teaches nothing of the kind. The cited section actually states:

Referring to FIGS. 1 and 3, an ultrasonic diagnostic imaging system 10 constructed in accordance with the principles of the present invention is shown. The ultrasound system 10 includes a number of conventional components, including a scanhead 14 with an ultrasonic transducer 12 which transmits ultrasonic waves into the body of a patient, receives echoes returning from the interaction of the transmitted waves with internal organs and tissue of the body, and converts the received echoes into electrical echo signals. The electrical echo signals are appropriately delayed and combined by a beamformer 16 to form coherent beams of echo information.

Col. 2, ll. 52-63.

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The cited section describes an ultrasound system that is readily capable of direct communications. The Examiner has ignored the fundamental differences in the claimed invention and Canfield, II et al., as well as explicit elements of the claims. The cited section does not teach a portable service interface of any kind, let alone "a portable service interface having software for communication with an on-line center." Should the Examiner disagree, Applicant again requests a pinpoint citation to explicitly show where, in all of Canfield, II et al., is "a portable service interface having software for communication with an on-line center" disclosed.

Claim 21 also calls for the portable service interface to perform a multitude of functions. The claim specifically calls for the portable service interface to (1) interface the in-field product with the on-line center through the portable service interface to conduct a diagnostic evaluation, (2) download information to the in-field product from the on-line center through the portable service interface, and (3) display one of the diagnostic evaluation and downloaded information on the portable service interface. To reject these elements, the Examiner cited various portions of column 8 of Canfield, II et al. However, column 8 actually teaches an electronic messaging system incorporating an ultrasound system. The ultrasound system of Canfield, II et al. is designed to directly communicate with other ultrasound systems as well as other external systems, such as a manufacturer. Such is simply not what the Examiner states it is.

Assuming arguendo that column 8 teaches ultrasound system operations that involve interfacing, downloading, and displaying – this is still not what is claimed. First, as previously addressed, claim 21 is clear that a portable service interface, not an ultrasound system, performs the operations of interfacing, downloading, and displaying. However, should the Examiner contend that an ultrasound system could be considered a portable service interface, Canfield, II et al. fails to teach an in-field product operable with the portable service interface. Second, claim 21 is explicit that the operations of interfacing, downloading, and displaying are performed in a very particular manner. That is, the interfacing is an interfacing between the in-field product with the on-line center through the portable service interface, the downloading is downloading information to the in-field product from the on-line center through the portable service interface, and the displaying is a displaying of one of the diagnostic evaluation and the downloaded information.



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Furthermore, the displaying is performed by the portable service interface. Canfield, II et al. makes no such teaching or suggestion.

Additionally, the Examiner has failed to meet the burden required to establish a *prima facie* case of obviousness under MPEP §2143. The Examiner cannot sustain the present rejection because (1) the references are directed to very different purposes and there is no motivation to combine these references in a way done so by the Examiner; (2) the combination does not have a reasonable expectation of success; and (3) all the elements of the present claims are not present in the references. The Examiner has not established any of these three required criteria under MPEP §2143 and, therefore, the current rejection is simply unsustainable. Therefore, claim 21 is patentably distinct from the cited art. Additionally, claims 22-24 are in condition for allowance at least pursuant to the chain of dependency.

#### **Provisional Double Patenting Rejection**

Applicant notes that the Examiner provisionally rejected claims 1-24 under the judicially created doctrine of double patenting over claims 1-44 of Application No. 09/199,506. However, due to the provisional nature of the rejection, Applicant is not in a position to provide remarks with respect to the provisional rejection. MPEP §804(I)(B) states that "[i]f the 'provisional' double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent." Therefore, since all other rejections are traversed, Applicant requests withdrawal of the provisional double patenting rejection and a timely issuance of a Notice of Allowance. However, should the 09/199,506 application issue prior to the issuance of the claimed invention and the provisional double patenting rejection ripens into a double patenting rejection, Applicant will readily address the applicability of the rejection at that time.

Therefore, in light of the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-24. Applicant notes that some of the above arguments were originally presented in the Response mailed August 22, 2003. However, as the Examiner clearly failed to appreciate or even respond to these remarks, Applicant has represented them herein. Accordingly, should the Examiner not find the remarks herein fully persuasive, Applicant requests full explanation from the Examiner setting forth the Examiner's reasons for finding each and every argument unpersuasive for purposes of Appeal.

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Applicant appreciates the Examiner's consideration of these Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved or require further explanation if the same would further prosecution of this case, pending since December 12, 1999.

Respectfully submitted,



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